REMARKS/ARGUMENTS

Claims 1-10 are pending in this application.

Claims 1-5, 7, 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Meadors et al. (U.S. 6,249,205) in view of Cassese et al. (U.S. 5,949,191). Claims 6 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Meadors et al. in view of Cassese et al., and further in view of Gu et al. (U.S. 5,499,005). Applicant respectfully traverses these rejections.

Claim 1 recites:

> "**A multilayer inductor** comprising:
> a plurality of magnetic layers stacked on each other;
> through-holes formed in the stacked magnetic layers; and
> a plurality of coil conductor patterns disposed between the plurality of magnetic layers and spirally connected to each other via the through-holes;
> **wherein the area of a projected plane of a circuit of each coil conductor pattern on a main surface of respective ones of the plurality of magnetic layers is in a range from about 35% to about 75% of the area of the main surface of the respective ones of the plurality of magnetic layers.**" (Emphasis added)

The Examiner acknowledged that Meadors et al. fails to teach or suggest each coil conductor pattern on the main surface of the plurality of magnetic layers being in the range of about 35% to about 75% of the area of the main surface of the respective ones of the plurality of magnetic layers. However, the Examiner alleged that Cassese et al. discloses a multi-layer device including a plurality of coil conductor patterns formed on a plurality of layers, wherein the coil conductor pattern on the main surface of the plurality of layers is in a range of about 35% to about 75% of the area of the main surface of the respective ones of the plurality of layers. Thus, the Examiner concluded that it would have been obvious to "use the coil conductor pattern design of Cassese et al. in Meadors et al. for the purpose of improving usage of the area of the conductive material and minimizing leakage inductance." Applicant respectfully disagrees.

Cassese et al. is directed to a dissipating transformer in a power supply circuit for

a motor vehicle headlight, which is **completely** unrelated to the inductor disclosed in Meadors et al. and as recited in the present claimed invention. In addition, Cassese et al. fails to teach or suggest that the structure disclosed in Cassese et al. could or should be used in an inductor, or that the structure of Cassese et al. is even suitable for use in a multilayer inductor. Thus, Applicant respectfully submits that there would have been absolutely **no** motivation to use the coil conductor pattern design of Cassese et al. in Meadors et al. as alleged by the Examiner. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger, 815 F.2d 686, 2 USPQ 1276, 1278 (Fed. Cir. 1987).

Furthermore, the Examiner alleged that the motivation to use the coil conductor pattern design of Cassese et al. in Meadors et al. would have been "for the purpose of improving usage of the area of the conductive material and minimizing leakage inductance." However, Cassese et al. fails to teach or suggest anything at all regarding improved usage of a conductive material or that the structure of Cassese et al. minimizes leakage inductance. In fact, Cassese et al. fails to even mention **any** inductance, and certainly fails to disclose anything at all about a leakage inductance. Thus, one of ordinary skill in the art could clearly **NOT** have been motivated to use the coil conductor pattern design of Cassese et al. in Meadors "for the purpose of improving usage of the area of the conductive material and minimizing leakage inductance" as alleged by the Examiner.

Instead of basing the conclusion of obviousness on actual teachings or suggestions of the prior art and the knowledge of one of ordinary skill in the art at the time the invention was made, the Examiner has improperly used Applicant's own invention as a guide. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art

to deprecate the claimed invention. In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

In addition, the Examiner alleged that Cassese et al. teaches "the area of a projected plane of a circuit of each coil conductor pattern on a main surface of respective ones of the plurality of magnetic layers is in a range from about 35% to about 75% of the area of the main surface of the respective ones of the plurality of magnetic layers." This is clearly incorrect. In fact, Cassese et al. fails to teach or suggest anything at all about the percentage of the main surface of the plurality of layers upon which the coil conductors are provided. Thus, contrary to the Examiner's allegations, Cassese et al. clearly fails to teach or suggest "the area of a projected plane of a circuit of each coil conductor pattern on a main surface of respective ones of the plurality of magnetic layers is in a range from about 35% to about 75% of the area of the main surface of the respective ones of the plurality of magnetic layers" as recited in the present claimed invention.

The PTO has the burden under 35 U.S.C. §103 to establish a prima facie case of obviousness. See In re Piasecki, 745 F .2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. See In re Fine, 837 F .2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1984). This it has not done. The Examiner failed to cite prior art that remedies the deficiencies of Meadors et al. and Cassese et al. or that suggests the obviousness of modifying Meadors et al. and Cassese et al. to achieve Applicant's claimed invention.

Prior art rejections must be based on evidence. Graham v. John Deere Co., 383 U.S. 117 (1966). Pursuant to MPEP 706.02(a), the Examiner is hereby requested to cite a reference in support of his position that it was well known at the time of Applicant's invention to provide coil conductor which are arranged such that "the area of a projected plane of a circuit of each coil conductor pattern on a main surface of

respective ones of the plurality of magnetic layers is in a range from about 35% to about 75% of the area of the main surface of the respective ones of the plurality of magnetic layers" as recited in the present claimed invention. If the rejection is based on facts within the personal knowledge of the Examiner, the data should be supported as specifically as possible and the rejection must be supported by an affidavit from the Examiner, which would be subject to contradiction or explanation by affidavit of Applicant or other persons. See 37 C.F.R. §1.104(d)(2).

Gu et al. is relied upon merely to allegedly teach C-shaped or ring-shaped coil conductor patterns, and certainly fails to teach or suggest "the coil conductor pattern on the main surface of the plurality of layers is in a range of about 35% to about 75% of the area of the main surface of the respective ones of the plurality of layers" as recited in the present claimed invention. Thus, Applicant respectfully submits that Gu et al. fails to cure the deficiencies of Meadors et al. and Cassese et al. described above.

Accordingly, Applicant respectfully submits that Meadors et al., Cassese et al. and Gu et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in claim 1 of the present application.

In view of the foregoing remarks, Applicant respectfully submits that claim 1 is allowable. Claims 2-10 depend upon claim 1, and are therefore allowable for at least the reasons that claim 1 is allowable.

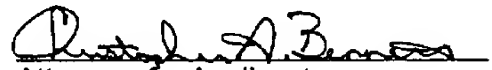
In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicant petitions the Commissioner for a ONE-month extension of time, extending to September 21, 2003, the period for response to the Office Action dated May 21, 2003.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: September 19, 2003



Attorneys for Applicant

Joseph R. Keating
Registration No. 37,368

Christopher A. Bennett
Registration No. 46,710

KEATING & BENNETT LLP
10400 Eaton Place, Suite 312
Fairfax, VA 22030
Telephone: (703) 385-5200
Facsimile: (703) 385-5080